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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,652	12/30/2003	Patrick D. Blattner	06975-467001/AOL 213	1574
26171 7590 03/23/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER VU, THANH T	
			ART UNIT 2174	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/747,652

Applicant(s)

BLATTNER ET AL.

Examiner

Thanh T. Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claims 21 and 52 are a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-8, 18-32, 35-43, 47-55, 57-58, 60-64, 66-67, and 69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Liles et al. ("Liles" U.S. Pat. No. 5,880,731).

Per claim 1, Liles teaches a method for communicating, the method comprising:
graphically representing, with an avatar capable of being animated, a first user in a communication session involving the first user and a second user (col. 3, lines 52-67);

communicating a message between the first user and the second user, the message conveying explicit information from the first user to the second user (col. 3, lines 32-41); and communicating out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, wherein the out-of-band communication comprises a communication that is related to a context of the first user and that differs from the information conveyed in the message sent between the first user and the second user (col. 3, lines 28-42; col. 9, lines 55-65; *a participant can select and animate the avatar related to a context of the participant along with text message sent between participants*).

Per claim 2, Liles teaches the method of claim 1 wherein the communication session is an instant messaging communication session (col. 3, lines 58-62; *online chat session*).

Per claim 3, Liles the method of claim 1 wherein the avatar comprises a facial animation that does not include a body having an ear or a leg (fig. 7; element 124; col. 7, lines 49-54; *a user can modify an animation to include or exclude various features*).

Per claim 4, Liles teaches the method of claim 1 wherein the avatar comprises a facial animation, including a neck, that does not include a body having an ear or a leg (fig. 7; animation 122; col. 7, lines 49-54; *a user can modify an animation to include or exclude various features*).

Per claim 7, Liles teaches the method of claim 1 wherein the out-of-band information comprises information indicating a personality characteristic associated with the first user (col. 6, lines 50-67; *character setting*).

Per claim 8, Liles teaches the method of claim 1 wherein the out-of-band information comprises information indicating an emotional state associated with the first user (col. 3, lines 32-34).

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Per claim 18, Liles teaches the method of claim 1 wherein out-of-band information comprises information related to a mood of the first user (fig. 7; col. 2, lines 32-34).

Per claim 19, Liles teaches the method of claim 18 wherein the mood of the first user comprises one of happy, sad or angry (fig. 7; col. 2, lines 32-34).

Per claim 20, Liles teaches the method of claim 1 wherein out-of-band information comprises information associated with an activity of the first user (col. 7, lines 18-42).

Per claim 21, Liles teaches the method of claim 20 wherein the activity is being performed by the first user at substantially the same time that the out-of-band message is communicated from the first user to the second user (col. 7, lines 18-42; *a user can perform an activity (i.e checking a watch) at the same time a message is sent to another user*).

Per claim 22, Liles teaches the method of claim 21 wherein the activity comprises one of working or listening to music (col. 7, lines 50-55; *a user works on customizing the avatar*).

Per claim 23, Liles teaches the method of claim 5 wherein out-of-band information comprises information conveying that the first user has muted sounds associated with the avatar (col. 9, lines 1-5; *user can modified the avatar completely as desired*).

Per claim 24, Liles teaches the method of claim 1 further comprising triggering, based on the information conveyed in the message from the first user to the second user, an animation of the avatar to convey the out-of-band information from the first user to the second user (col. 7, lines 18-22; col. 9, lines 55-65 and col. 10, lines 28-32; *a user can select an animation to convey a message to send to another user*).

Per claim 25, Liles teaches the method of claim 24 wherein the trigger comprises a portion of text (col. 9, lines 55-65).

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Per claim 26, Liles teaches the method of claim 24 wherein the trigger comprises all of the text of the message (col. 9, lines 55-65 and col. 10, lines 28-32; *a user can select an animation in response to messages sent between the users*).

Per claim 27, Liles teaches the method of claim 24 wherein the trigger comprises an audio portion of the message (col. 9, lines 55-65 and col. 10, lines 28-32; col. 13, lines 35-41; *a user can select an animation in response to the sound when a user joins the chat session*).

Per claim 28, Liles teaches the method of claim 24 wherein the trigger comprises passing a predetermined amount of time during which the first user does not communicate a message to the second user (col. 9, lines 24-26).

Per claim 29, Liles teaches the method of claim 24 wherein the trigger comprises passing a predetermined amount of time during which the first user does not use a computing device that is used by the first user to communicate with the second user in the communication session (col. 9, lines 24-26).

Per claim 30, Liles teaches the method of claim 1 wherein the avatar animation used as the communication conduit comprises a facial expression of the avatar (fig. 7).

Per claim 31, Liles teaches the method of claim 1 wherein the avatar animation used as the communication conduit comprises a gesture made by a hand of the avatar or a gesture made by an arm of the avatar (col. 7, lines 30-35).

Per claim 32, Liles teaches the method of claim 1 wherein the avatar animation used as the communication conduit comprises movement of a body of the avatar (col. 7, lines 30-35).

Per claim 35, Liles teaches the method of claim 1 wherein the avatar animation used as the communication conduit comprises a breakout animation that involves displaying avatar outside of normal display space occupied by the avatar (col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired and move avatar within the room*).

Per claim 36, Liles teaches the method of claim 35 wherein the breakout animation comprises telescoping the avatar (co. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired*).

Per claim 37, Liles teaches the method of claim 35 wherein the breakout animation comprises resizing the avatar (co. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired*).

Per claim 38, Liles teaches the method of claim 35 wherein the breakout animation comprises repositioning the avatar (col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired and move avatar within the room*).

Per claim 39, Liles teaches the method of claim 1 further comprising providing the first user with multiple preconfigured avatars having associated preselected animations and enabling the first user to select a particular avatar to represent the user in the communications session (col. 9, lines 34-46).

Per claim 40, Liles teaches the method of claim 39 further comprising persistently associating the first user with the selected avatar to represent the first user in subsequent communication sessions (col. 9, lines 34-46; *a user can select an avatar to represent the user*).

Per claim 41, Liles teaches the method of claim 39 further comprising enabling the first user to modify the appearance of the avatar (col. 9, lines 1-5).

Per claim 42, Liles teaches the method of claim 41 wherein enabling the first user to modify the appearance of the avatar comprises enabling the first user to use a slide bar to indicate a particular modification of a particular feature of the avatar (fig. 3; *a user can use the scroll bar to select a different avatar to change the appearance of the avatar in the chat room*).

Per claim 43, Liles teaches the method of claim 41 wherein enabling the first user to modify the appearance of the avatar comprises enabling the first user to modify appearance of the avatar to reflect a characteristic of the first user (fig. 3; col. 9, lines 1-5; *a user can select an avatar to reflect a characteristic of the user or modify the avatar as desired*).

Per claim 47, Liles teaches the method of claim 1 further comprising enabling the first user to modify a trigger used to cause an animation of the avatar (col. 8, line 61-col. 9, line 5).

Per claim 48, Liles the method of claim 47 wherein the trigger comprises text included in the message sent from the first user to the second user (col. 7, lines 18-22; col. 9, lines 55-65; *a user can select animation in response to message sent between the users*).

Per claim 49, Liles teaches the method of claim 1 further comprising animating the avatar for use as an information assistant to convey information to the first user (col. 7, lines 25-35).

Per claim 50, Liles teaches the method of claim 1 further comprising enabling use of the avatar by an application other than a communications application (col. 9, lines 4-15; *a bitmap file can be view by other application that is able to view bitmap files*).

Per claim 51, Liles teaches the method of claim 50 wherein enabling use of the avatar by an application other than a communications application comprises enabling use of the avatar in an online journal (col. 9, lines 4-15; *a bitmap file can be view by other application that is able to view bitmap files*).

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Per claim 52, Liles teaches the method of claim 1 further comprising displaying a depiction of the avatar in the form that is substantially similar to a trading card (col. 9, lines 9-15; *a user can send their customized avatar to other users*).

Per claim 53, Liles teaches the method of claim 52 wherein the trading card depiction of the avatar comprises a trading card depiction of the avatar that includes characteristics associated with the first user (col. 1-5; *a user can customized the avatars as desired*).

Claims 54 and 55 are rejected under the same rationale as claims 1 and 2 respectively.

Claims 57 and 58 are rejected under the same rationale as claims 7 and 8 respectively.

Claims 60, 61, and 62 are rejected under the same rationale as claims 18, 20, 47 respectively.

Claims 63 and 64 are rejected under the same rationale as claims 1 and 2 respectively.

Claims 66 and 67 are rejected under the same rationale as claims 7 and 8 respectively.

Claims 69, 70, and 71 are rejected under the same rationale as claims 18, 20, 47 respectively.

Claim 72 is rejected under the same rationale as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5-6, 9-17, 56, 59, 65, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Kim et al. ("Kim", WO 01/84461 A1).

Per claim 5, Liles teaches the method of claim 1, but does not teaches wherein the out-of-band information comprises information indicating an environmental condition associated with the first user. However, Kim teaches the out-of-band information comprises information indicating an environmental condition associated with the first user (page 2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of Liles because it provides users with an enjoyable on-line chatting using various setting for a character in the virtual world that reflect the real world setting of a user.

Per claim 6, Liles teaches the method of claim 5 wherein the environmental condition comprises an environmental condition related to weather occurring in a geographic location near the first user (col. 2, lines 10-14 and lines 28-30).

Per claim 9, Liles teaches the method of claim 1, but does not specifically teach wherein the out-of-band information comprises information indicating a setting characteristic associated with the first user. However, Kim teaches the out-of-band information comprises information indicating a setting characteristic associated with the first user (page 2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of Liles because it provides users with an enjoyable on-line chatting using various setting for a character in the virtual world that reflect the real world setting of a user.

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Per claim 10, Kim teaches the method of claim 9 wherein the setting characteristic comprises a characteristic related to time of day of the first user (col. 2, line 23).

Per claim 11, Kim teaches the method of claim 9 wherein the setting characteristic comprises a characteristic related to time of year (col. 2, lines 5-9).

Per claim 12, Kim teaches the method of claim 11 wherein the time of year comprises a holiday (col. 2, lines 5-9; *each season comprises a holiday*).

Per claim 13, Kim teaches the method of claim 11 wherein the time of year comprises a season wherein the season is one of spring, summer, fall or winter (col. 2, lines 5-9).

Per claim 14, Kim teaches the method of claim 9 wherein the setting characteristic comprises a characteristic associated with a work setting (col. 2, lines 10-14 and lines 29-34; *geographic setting or physical location of the user*).

Per claims 15-17, Kim teaches the method of claim 9 wherein the setting characteristic comprises a characteristic associated with a recreation setting such as a beach setting, a tropical setting, or a winter sport setting (col. 2, lines 10-14 and lines 29-34; *it is noted the geographic setting where the user lives or physical location of the user may comprises a recreation setting*).

Claim 56 is rejected under the same rationale as claim 5.

Claim 59 is rejected under the same rationale as claim 9.

Claim 65 is rejected under the same rationale as claim 5.

Claim 68 is rejected under the same rationale as claim 9.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Matsuda (U.S. Pat. No. 7,007,065).

Per claims 33 and 34, Liles teaches the method of claim 1, but does not teach wherein the avatar animation used as the communication conduit comprises sounds made by the avatar, and wherein at least some of the sounds comprise a voice based on a voice of the first user. However Matsuda teaches wherein the avatar animation used as the communication conduit comprises sounds made by the avatar, and wherein at least some of the sounds comprise a voice based on a voice of the first user (col. 1, lines 8-10; col. 3, lines 30-34; col. 5, lines 50-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Matsuda in the invention of Liles in order to provide an avatar that is active in a shared virtual space, and made to output a sound during a chat.

Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Ostermann et al. ("Ostermann", U.S. Pat. No. 7,177,811).

Per claims 44-46, Liles teaches modification of the appearance and characteristic of a user as described above, but does not specifically teach wherein the characteristic of the first user comprises one of age, gender, hair color, eye color, or a facial feature, the appearance of the avatar comprises enabling the first user to modify appearance of the avatar by adding, changing or deleting a prop displayed with the avatar, and wherein the prop comprises one of eyeglasses, sunglasses, a hat, or earrings. However, Ostermann teaches wherein the characteristic of the first user comprises one of age, gender, hair color, eye color, or a facial feature, the appearance of the avatar comprises enabling the first user to modify appearance of the avatar by adding, changing or deleting a prop displayed with the avatar, and wherein the prop comprises one of eyeglasses, sunglasses, a hat, or earrings (fig. 9; col. 11, line 60-col. 12, line 8).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Ostermann in the invention of Liles in order to provide further customizations to the user's avatar in a chat session.

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